

In re Patent Application of
THOMSON ET AL.
Serial No. 09/658,509
Filed: SEPTEMBER 8, 2000

REMARKS

Applicants thank the Examiner for the careful and thorough examination of the present application. By this amendment, Claims 1, 11 and 20 have been amended to clarify various features and thereby eliminate minor informalities contained therein. Claims 1, 3, 4, 6-14 and 16-27 remain pending in the application. Favorable reconsideration is respectfully requested.

I. The Amended Claims

Independent Claim 1 is directed to a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube. Claim 1 has been amended to recite that it includes a body portion having a tubular shape with a hollow interior and opposing first and second ends, the first end of the body portion being open and defining a generally circular opening. Support for this amendment is found with reference to FIGS. 19 and 20, and their related description. Claim 1 has also been amended to recite that the cavity in the recess of the handlebar clamping member is defined by an outermost wall spaced from opposing portions of the handlebar as can be seen in the cross-sectional view of FIG. 19, for example. In addition, Claim 1 has been amended to recite that the cavity in the recess of the handlebar clamping member has a width substantially the same as a diameter of the circular opening of the first end of the body portion. This can be seen in FIG. 19, for example, as the cavity 52 is as wide as the opening 66 of the body portion 31. Lastly, Claim 1 has been amended to recite that the cavity of the recess of the

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handlebar clamping portion has an opening therein aligned with the circular opening of the first end of the body portion. This can also be seen with reference to FIGS. 19 and 20, for example, which illustrates that the cavity 53 of the clamping portion 32 has an opening (at the bottom) that is aligned with the circular opening 66 of the body portion 31. Independent Claims 11 and 20 have been similarly amended.

In other words, several other significant features of the stem are now recited in the claims. The alignment of the opening in the end of the tubular body is described with respect to the opening in the handlebar clamping portion. The lateral extent or width of the cavity of the handlebar clamping member has been related to the diameter of the opening in the end of the tubular body. In addition, the spaced relationship between the cavity wall of the handlebar clamping member and the handlebar has also been recited in the claims.

II. The Claims are Patentable

Independent Claim 1 was rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth on page 3 of the Office Action. In the previous amendment, Applicants inadvertently referred to the "second end" of the body portion, but in the present amendment have amended Claim 1 to more accurately refer to the "first end" of the body portion. As can be clearly seen in Figs. 19-21, the first end of the body portion 31, where the clamping portion 32 is connected thereto, has a circular opening 66 and is aligned with the

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opening in the cavity of the clamping portion 32. Accordingly, Applicants maintain that Claim 1 and dependent claims thereof comply with the requirements of 35 U.S.C. §112, first paragraph, and the rejection should be withdrawn.

Claims 1, 3, 4, 6-14 and 16-27 were rejected as allegedly being indefinite for the reasons set forth on pages 3 and 4 of the Office Action.

Applicants have amended the independent claims to refer to the "width" of the cavity of the recess of the clamping member to aid the Examiner's understanding of the claimed feature. It should now be clear that the width of the cavity 52 of the recess of the clamping member 50 is the same as the diameter of the circular opening 66 of the end of the body portion 31.

Additionally, Applicants have amend the independent claims to refer to the outermost wall in the cavity 52 being spaced from the handlebar, as suggested by the Examiner.

Regarding the "circular opening" at the "open end" of the body portion, and the "opening" in the cavity of the clamping portion, as recited in Claims 11 and 20, Applicants refer the Examiner to Figs. 19 and 20, for example, which illustrate that the cavity 53 of the clamping portion 32 has an opening (at the bottom) that is aligned with the circular opening 66 at the open end of the body portion 31. It is pointed out that the clamping portion is recited as being connected to the open end of the body portion, and it should be clear that the respective openings are aligned.

Applicants point out that the Examiner's focus during examination of claims for compliance with the

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requirement for definiteness of 35 U.S.C. §112, second paragraph should be whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the Examiner might desire. Examiners should not reject claims or insist on their own preferences if other modes of expression selected by Applicants satisfy the statutory requirement.

As the Examiner is aware, the essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. §112, second paragraph is not appropriate.

Accordingly, Applicants believe that Claims 1, 3, 4, 6-14 and 16-27 meet the statutory requirements of 35 U.S.C. §112, second paragraph. Thus, the rejection under 35 U.S.C. §112, second paragraph, should be withdrawn

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Claims 1, 3, 4, 6-14 and 16-27 were rejected in view of Giard (U.S. Patent No. 6,058,800) in view of Jeshurun et al. (U.S. Patent No. 5,165,301) and Lai (U.S. Patent No. 5,509,328) for the reasons set forth on pages 5-13 of the Office Action. Applicants contend that Claims 1- clearly define over the cited reference, and in view of the following remarks, favorable reconsideration of the rejection under 35 U.S.C. §103 is requested.

Applicants submit that the combination of Giard, Jeshurun et al. and Lai fails to teach or suggest the claimed invention for at least the reasons set forth in the previous response. Additionally, Applicants note that the Examiner specifically did not address the claimed features of: the alignment of the opening in the end of the tubular body with respect to the opening in the handlebar clamping portion; the lateral extent or width of the cavity of the handlebar clamping member being related to the diameter of the opening in the end of the tubular body; and the spaced relationship between the cavity wall of the handlebar clamping member and the handlebar. There is simply no teaching or suggestion in the cited references to provide the combination of features as claimed.

Accordingly, for at least the reasons given above, Applicants maintain that the cited references do not disclose or fairly suggest the invention as set forth in Claims 1, 11 and 20. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. Thus, the rejections under 35 U.S.C. §103(a) should be withdrawn.

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It is submitted that the independent claims are patentable over the prior art. In view of the patentability of the independent claims, it is submitted that their dependent claims, which recite yet further distinguishing features are also patentable over the cited references for at least the reasons set forth above. Accordingly, these dependent claims require no further discussion herein.

III. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. An early notice thereof is earnestly solicited. If, after reviewing this Response, there are any remaining informalities which need to be resolved before the application can be passed to issue, the Examiner is invited and respectfully requested to contact the undersigned by telephone in order to resolve such informalities.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY that the foregoing correspondence has
been forwarded via facsimile number 703-872-9306 to the
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